

*See also Vol. 3085*

No. 15,986 ✓

IN THE

**United States Court of Appeals  
For the Ninth Circuit**

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ELRICK RIM COMPANY, a copartnership  
consisting of M. C. Elrick and M. B.  
Champlin,

*Appellant,*

vs.

READING TIRE MACHINERY CO., INC., a  
corporation, and RALPH R. READING,  
an individual,

*Appellees.*

**PETITION FOR A REHEARING ON BEHALF OF APPELLANT,  
ELRICK RIM COMPANY, A COPARTNERSHIP, CONSISTING  
OF M. C. ELRICK AND M. B. CHAMPLIN.**

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**FILED**

MAR 26 1959

PAUL P. O'BRIEN, CLERK



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This court's decision is incorrect, as a matter of law, because an important and critical part of Reading's invention is the use of a pressure in the independent stream of air to the spray gun of from 150 to 200 pounds; the language of the Reading claims is free from ambiguity; therefore the claims must, without reference to the specifications, particularly point out and distinctly claim the invention . . . .	2
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*To the Honorable Stanley N. Barnes, Frederick G. Ham-  
ley and Gilbert H. Jertberg, Circuit Judges of the  
United States Court of Appeals for the Ninth Circuit:*

The appellant, above named, feeling itself aggrieved  
by the opinion filed in this Court on March 4, 1959, comes  
now and respectfully petitions for a rehearing limited to  
the following question:

Is it proper, as a matter of law, to refer to the specifi-  
cations of a patent to limit the claims to "particularly

point out and distinctly claim'' an identifiable invention or discovery when said claims are free from ambiguity?

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THIS COURT'S DECISION IS INCORRECT, AS A MATTER OF LAW, BECAUSE AN IMPORTANT AND CRITICAL PART OF READING'S INVENTION IS THE USE OF A PRESSURE IN THE INDEPENDENT STREAM OF AIR TO THE SPRAY GUN OF FROM 150 TO 200 POUNDS; THE LANGUAGE OF THE READING CLAIMS IS FREE FROM AMBIGUITY; THEREFORE THE CLAIMS MUST, WITHOUT REFERENCE TO THE SPECIFICATIONS, PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE INVENTION.

The Court in its opinion, pages 4 and 5, said that the use of the application pressure in the independent air line in the 150-200 pound range and the obtaining of an emulsion effect in the rubber cement were the new techniques of the Reading process, stating:

"The high pressure in the independent air line, as taught by Reading, reaches a magnitude of from one hundred fifty to two hundred pounds per square inch. This makes possible the application of an exceedingly thin coating of rubber cement which dries quickly, thereby saving time and avoiding the dust, moisture, and health hazards associated with former methods. The utilization of high air pressure in the bypass line also aids in overcoming the 'cobwebbing' effect to which reference has been made. In addition the high air pressure utilized in the Reading process causes the mixture to attain and retain an air volume above the flammable limits of the solvent. The need of extreme care to avoid the danger of fire or explosion is thus overcome."

\* \* \* \* \*

“In paint spraying the application of air pressure in the independent air line in the 150 to 200-pound range is unnecessary and in fact undesirable. Likewise, there is no advantage in obtaining an emulsion effect where paint is to be sprayed. *In these two particulars Reading teaches a process not contemplated by Shelburne, Gradolph or McLean.*”<sup>1</sup>

The Court, in its opinion, went on to say the following at page 10:

“The trial court concluded that the use which Reading made of the known paint spraying devices was not analogous to the uses for which they were originally designed. The Court based this conclusion on its findings of fact *that Reading was the first to use excess air pressure in the independent air line* and to obtain emulsion within the tank of liquid, both of these techniques being undesirable in the case of spray painting. In our view these two variances are sufficient to warrant the conclusion that Reading teaches a nonanalogous art and is therefore a ‘new’ use of a known machine within the meaning of §100 (b).”

Again the Court continued to stress the importance of the excess pressure in the independent stream of air on pages 11 and 12 of its opinion, where it said:

“\* \* \* The independent air line under Reading is used at pressures far above those contemplated by Shelburne and the other devices, though within the physical capability of those devices. Again, the use of this excessive pressure is to be desired in applying liquid cement and to be avoided in applying paint.”

\* \* \* \* \*

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<sup>1</sup>All emphasis ours unless otherwise stated.



“It is true, as appellant points out, that any mechanic can install an air inlet tube or regulate air pressure. But these steps were not taken in the manner and for the purpose contemplated by the Reading method until he discovered an advantage in doing so. When they were taken, new, unexpected, and extremely useful results were achieved.”

From the above quotations it is seen that the only novel steps of the Reading process are the use of an excess pressure of from 150 to 200 pounds in the independent air line and the formation of an emulsion of air in the cement. If these two steps are the novel features of the Reading invention, then they should be properly claimed. Limiting our consideration, in the present petition, to the excess pressure employed in the independent air line, let us examine the Reading patent to find what it says about the pressure in the independent air line.

The Reading specification makes only one statement with respect to the pressure of air in the independent air line, stating that it is a pressure of “about 150 to 200 pounds per square inch”. (Ex. 1, Col. 4, lines 33 and 34, R. 706). This Court recognized that the use of this pressure was one of the novel features of the Reading invention. We submit that such a pressure is critical to the practice of the Reading invention and is a necessary part of said process.

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#### **CLAIMS ARE FREE FROM AMBIGUITY.**

We submit that the language of each of the claims of the Reading patent is clear and understandable and is free from ambiguity.



What do the claims of the Reading patent say with respect to the pressure to be used in the independent stream of air?

The process defined in claim 1 is as follows:

“A method of applying rubber cement which includes an inflammable solvent,

comprising forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure into a substantial body of cement maintained in said zone at superatmospheric pressure continuously withdrawing a stream of the emulsion from the dispersion zone,

*forming an independent stream of air,*

continuously mixing the emulsion stream with said independent stream of air in a mixing zone,

and continuously directing the resulting mixture of emulsion and air onto a surface to form a thin uniform coating of rubber cement thereon.”

The process of claim 2 is the following:

“A method of applying rubber cement which includes an inflammable solvent,

comprising introducing a measured amount of the cement into a dispersion zone,

introducing a quantity of air at superatmospheric pressure into the cement under emulsion conditions to form a stable dispersion of gas and cement under pressure,

continuously withdrawing a stream of the emulsion from the dispersion zone,

*continuously withdrawing a separate stream of air from a source of air under superatmospheric pressure,*

continuously mixing the streams of emulsion and said separate stream of air in a mixing zone to form a spray of emulsion suspended in air, and continuously directing the resulting spray onto a surface to form a thin uniform coating of rubber cement thereon.”

Claim 3 defines the process in the following way:

“A method of applying rubber cement comprising introducing a measured amount of liquid rubber cement composition comprising an elastomer and an inflammable solvent into an enclosed dispersion zone,

introducing a quantity of air into the cement under conditions to form an emulsion of air in the liquid cement at a pressure in the range of about 5 pounds to about 200 pounds per square inch,

continuously withdrawing a stream of the emulsion from the dispersion zone,

*continuously withdrawing a separate stream of air from a source of air under superatmospheric pressure,*

continuously mixing the streams of emulsion and air in a mixing zone to form a spray of emulsion suspended in gas,

and continuously directing the resulting spray onto a surface to form a thin uniform coating of rubber cement thereon.”

Claim 4 defines the process as follows:

“A method of applying rubber cement to a surface comprising

introducing about 2.5 volumes of liquid rubber cement composition comprising rubber and an in-

flammable solvent into an enclosed dispersion zone of about 3.0 volumes capacity,

introducing a quantity of air into the liquid cement under conditions to form an emulsion of air in the cement at a pressure in the range of about 5 pounds to about 200 pounds per square inch,

continuously withdrawing a stream of the emulsion from the dispersion zone,

*continuously withdrawing a stream of air from a source of air under superatmospheric pressure,*

continuously mixing the streams of emulsion and air in a mixing zone to form a spray of emulsion suspended in air containing of the order of a fraction of an ounce of cement to several cubic feet of air,

and continuously directing the resulting spray onto a surface to form a thin uniform coating of rubber cement thereon."

It is submitted that the above quoted claims are free from ambiguity. No contention has ever been made that the claims are ambiguous. On the contrary, the claims have always been considered free from ambiguity.

Let us now examine these claims to determine whether or not they overclaim the invention with particular reference to the pressures called for in said claims for the independent stream of air. Just what pressures are included in each of said claims for the independent stream of air by the language employed therein?

Claim 1 calls only for "forming an independent stream of air". No pressure whatsoever is here specified. In applying this language to a process of spraying rubber

cement, a pressure of from 1 pound per square inch on up to the highest pressure obtainable is included. Would the practicing of a process of spraying rubber cement using all of the steps of the Reading process, except using one pound pressure on the independent stream, be an infringement of the Reading patent? Suppose the pressure in the independent stream of air was raised to 5 pounds, 10 pounds, 30 pounds, 60 pounds, 120 pounds, 140 pounds, 210 pounds or, for example, say 1000 pounds—would this be the Reading process? The invention defined by Claim 1 includes all of the above pressures. The metes and bounds of an invention are described by the claims of the patent. Claim 1 of Reading contains no limitation whatsoever respecting the pressures to be employed in the independent air line. We submit, therefore, that Claim 1 does not properly point out and distinctly claim the Reading invention but rather overclaims the invention. Said claim, being free from ambiguity, is invalid as a matter of law.

Let us now examine Claims 2, 3 and 4 and determine what pressures are called for in the independent stream of air in these three claims. Each of these claims calls for the air in the independent stream to be “air under superatmospheric pressure”. What does “superatmospheric pressure” mean? Atmospheric pressure at sea level is 14.6974 pounds per square inch (Hackh’s Dictionary, 3rd Edition, Page 82, Definition of “Atmosphere”). A pressure of 15 pounds at sea level would be superatmospheric pressure. Therefore, if one used all of the steps of the Reading process employing a pressure of *only 15 pounds* per square inch in the independent air

line, he would infringe Claims 2, 3 and 4 of the Reading patent. Likewise, if one employed *any pressure over 14.6974 pounds* per square inch, he would infringe these claims. Again we submit Claims 2, 3 and 4 overclaim the Reading invention. These claims are free from ambiguity. Therefore, they should of themselves “particularly point out and distinctly claim” Reading’s invention. In overclaiming the invention, we submit each of said claims, as a matter of law, is invalid.

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**THE PATENT IN SUIT IS INVALID, AS A MATTER OF LAW, FOR  
FAILURE TO COMPLY WITH THE PROVISIONS OF SECTION  
112 OF TITLE 35, UNITED STATES CODE.**

Section 112 of Title 35 U.S.C.<sup>2</sup> requires that the specifications contain a sufficient description of the invention to enable one skilled in the art to make and use the same and, in addition, requires that the claims must particularly point out and distinctly claim what the invention is. This defense is not a technical defense and has frequently been upheld by the Courts. The necessity of a proper disclosure and a proper claiming of the invention, to enable the public to make and use the invention after the monopoly

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<sup>2</sup>The specifications shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. \* \* \*



has expired, is one of the major considerations for the issuance of a patent to an inventor. The metes and bounds of the patent must be set forth in order that those skilled in the art may know what monopoly is asserted and to enable them to use other processes, structures and devices not covered by said monopoly.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 83 L. Ed. 34, 39, 305 U.S. 46

*General Electric Co. v. Wabash Appliance Corp.*, 82 L. Ed. 1402, 1405, 304 U.S. 364

*United Carbon Co. v. Binney & Smith Co.*, 87 L. Ed. 232, 237, 317 U.S. 228

With reference to the claims of the Reading patent, they do not define or set forth the particular part of the process which causes the combination of the steps of the process to accomplish the claimed function and result relied upon by Reading to support the claims. The claims are not limited to any particular pressure in the independent stream of air going to the spray gun. Mr. Reading testified (R. 364-365) that the pressure employed in the independent stream of air is critical, stating:

“Q. Now, is it your contention that the bypass pressure that you employ in your independent stream of air is critical in the practice of your process?

A. Yes; in a sense it is critical. It has to be. May I explain that?

Q. Yes; go ahead.

A. It has to be high enough in pressure so that it avoids cobwebbing of your material as it comes out of the gun, and it has to be high enough that it drives the cement deeply into the buffed pores of the tire.’”

This Court, in holding the claims valid, reads into them certain pressure limitations which are necessary to properly limit and define Reading's invention.

There is no place in the claims where there is any definition of the invention which would enable an alleged infringer to know what he was infringing. There is nothing in the claims by which an alleged infringer could determine what pressures he could use in his independent air stream to avoid infringement of the claims. The excess pressure of air in the independent air line is the critical step in the Reading process which this Court in its opinion (pages 4 and 5) states makes possible "an exceedingly thin coating of rubber cement", which cement "dries quickly", results in "saving time and avoiding the dust, moisture and health hazards"; it "also aids in overcoming the cobwebbing effect" and finally causes the mixture of cement and solvent to "retain an air volume above the flammable limits of the solvent". The claims, however, fail to advise the public what pressure to use to accomplish all these results or, just as important, there is nothing in the claims which permits a person to determine what pressures can be employed to avoid infringement.

Undoubtedly, the question of infringement is predicated upon varying degrees of the pressure employed in the independent stream of air. If the question of degree is important, it must be set forth and must be claimed so as to enable the public to know the limits of the claimed invention.

*Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261,  
37 S. Ct. 82



It is submitted that, as a matter of law, the defense of failure to comply with the provisions of Section 112, upon the record, is sufficient to invalidate the claims of the Reading patent and this Court should grant a rehearing herein.

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**THIS COURT INCORRECTLY APPLIED THE LAW IN  
HOLDING THE READING CLAIMS VALID.**

This Court, in validating the claims, stated on page 12 of its opinion the following:

“Appellant challenges the legal sufficiency of the specific claims set out in Reading’s patent. In our view, however, the stated claims of the patent read in the light of the patent specifications are legally sufficient within the meaning of 35 U.S.C.A., § 112.”

The question of law here involved is whether or not, where the claims are free from ambiguity, reference may be had to the specifications for the purpose of interpreting and limiting the claims. Each of the claims of the Reading patent, as stated in the patent, is clear, understandable and free from ambiguity.

We believe the analysis of the claims hereinabove set forth establishes that so far as Claim 1 is concerned, any pressure whatever in the independent air line, from 1 pound per square inch on up to infinity, comes within the scope of said claim. Similarly, with respect to Claims 2, 3 and 4, any pressure whatsoever in the independent air line, from 14.6974 pounds per square inch on up to infinity, comes within the scope of these claims.

Unquestionably, in rendering its decision, this Court did not appreciate nor apply the doctrine of patent law

recently expressed by the Supreme Court of the United States in the case of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 69 S. Ct. 535, which doctrine was adopted and applied by this Court in the case of *Winslow Engineering Company v. Smith*, 223 F. 2d 438.

As we have heretofore stated, one of the important contributions that Reading made in the spray art, and a critical point of novelty of his invention, is the use of from 150 to 200 pounds pressure in the independent stream of air. The claims should in and of themselves particularly point out and distinctly claim this contribution or invention of Reading's. In this they fail.

We submit, in view of the fact that the claims of the Reading patent are free from ambiguity, it is improper, as a matter of law, to refer to the specifications to limit the claims so they can be considered valid and thus define the invention of Reading. Therefore, when this Court stated, in its opinion: "In our view, however, the stated claims of the patent read in the light of the patent specification are legally sufficient within the meaning of 35 U.S.C.A., Section 112.", it violated the provisions of 35 U.S.C.A., Section 112, as interpreted and applied by the Supreme Court and a previous decision of this Court.

The proper application of the statute to the instant case is that expressed in the *Graver Tank* case, *supra*, wherein the Supreme Court, in reversing the Court of Appeals, which construed the claims in question as narrowed and limited by the specification, said:

"The difference between the District Court and the Court of Appeals as to these findings comes to this: The trial court looked at claims 24 and 26 alone and

declined to interpret the terms 'silicates' and 'metallic silicates' therein as being limited or qualified by specifications to mean only the nine metallic silicates which had been proved operative. The District Court considered that the claims therefore were too broad and comprehended more than the invention. The Court of Appeals considered that because there was nothing in the record to show that the applicants for the patent intended by these claims to assert a monopoly broader than nine metallic silicates named in the specifications, the court should have construed the claims as thus narrowed and limited by the specifications.

The statute makes provision for specifications separately from the claims and requires that the latter 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' R.S. § 4888, as amended, 35 U.S.C. § 33, 35 U.S.C.A. § 33. It would accomplish little to require that claims be separately written if they are not to be separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to 'particularly point out and distinctly claim' an identifiable invention or discovery. We have frequently held that it is the claim which measures the grant to the patentee. See, for example, *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145, 62 S. Ct. 969, 970, 86 L.Ed. 1332; *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 58 S. Ct. 899, 901, 82 L. Ed. 1402; *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 487, 55 S. Ct. 455, 459, 79 L. Ed. 1005. While the cases more often have dealt

with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. Cf. *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 373, 374, 58 S. Ct. 899, 903, 904, 82 L. Ed. 1402; see *McClain v. Ortmayer*, 141 U.S. 419, 424, 425, 12 S. Ct. 76, 77, 78, 35 L. Ed. 800; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399, 410, 25 S. Ct. 697, 702, 49 L. Ed. 1100."

It is clear from this *Graver Tank* decision that reference to the specifications cannot be made to limit the claims when said claims are free from ambiguity.

This Court in the case of *Winslow Engineering Company v. Smith*, 223 F. 2d 438, had occasion to apply the Supreme Court's doctrine enunciated in the *Graver Tank* case and in doing so followed the rule that where the claims are free from ambiguity, the claims themselves must particularly point out and distinctly claim the invention without reference to the specification, stating at page 442 the following:

"The difficulty which the appellant here confronts relates to the statement of its claims which were three in number. Claim 1 is representative and reads as follows: '1. An oil conditioner element comprising a cylindrical body with a central cylindrical, hollow, rigid, perforate core, a tubular fabric casing having its ends secured to corresponding ends of the core, the ends of the fabric casing passing over the



respective ends of the core, the means for securing said ends of the tubular fabric comprising plugs for frictionally holding the fabric against the interior of the core, and a compacted mass of filtering material within the space enclosed between the casing and core, at least one of said plugs being hollow to afford communication with the interior of the core.' It will be noted that there is no reference in this claim to any part or feature suggestive of the growth factor to which we have previously referred and about which Winslow undertook to build its invention. The claim does not allude to the growth or expansion of the filtering material; nor is there any allusion to any knitted fabric, the reference being to a 'tubular fabric casing'. Appellant concedes that an ordinary woven fabric, not knitted, would not infringe its patent. It is apparent that the language quoted from Claim 1 would be equally descriptive of filters conforming to the prior art.

The appellant says that notwithstanding this condition of the statements of its claims, they must be read as incorporating the real invention as found in the specification and drawings. It says: 'The specification may be referred to in order to limit the claim'.

It is true that the specifications when read with the drawings, if added to or incorporated in these claims would accomplish the required limitation necessary to specify the combination constituting the invention. The description in the specifications clearly refers to 'a porous knitted sleeve of fabric', and in describing the elements states that it is 'flexible and normally grows in volume as deleterious substances are collected and absorbed within the body of the element'. It refers to the growing action which 'naturally opens

up the porosity on the exterior surface which not only prevents clogging of the outside surface but almost continuously presents new exposed surfaces of the unused chemically treated purifying materials within the body of the element itself.' ”

Note the similarity of the critical phrases employed in the Winslow claims and the Reading claims. The Winslow claims call for “tubular fabric casing” while the Winslow specification refers to “a porous knitted sleeve of fabric” that is “flexible and normally grows in volume as deleterious substances are collected and absorbed within the body of the element”, and then describes the growing action of the casing which “naturally opens up the porosity on the exterior surface which not only prevents clogging of the outside surface but almost continuously presents new exposed surfaces of the unusual chemically treated purifying materials within the body of the element itself.” The Reading claim calls for “an independent stream of air” (Claim 1) or “air under superatmospheric pressure” (Claims 2, 3 and 4), while the specification refers to “The pressure of the compressed air fed to the spray gun 27 is set at about 150 to 200 pounds per square inch . . .” (Ex. 1, Col. 4, lines 32-34, R. 706). This reference to “150-200 pounds per square inch” is the only statement in the patent respecting the pressure employed in the independent air line.

Applying the *Graver Tank* case rule of law to the *Winslow* case, this Court said:

“We think, however, that *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 277, 69 S. Ct. 535, 538, 93 L. Ed. 672, compels us to hold that

these claims are invalid. In that case the district court had held that certain of the claims were too broad and comprehended more than the invention. The court of appeals disagreed holding that the claims should be held to be limited to certain items named in the specifications and said that the district court should have construed the claims: 'as thus narrowed and limited by the specifications.' The Supreme Court said, 336 U.S. at page 277, 69 S. Ct. at page 538: 'The statute makes provision for specification separately from the claims and requires that the latter "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."' R.S. § 4888, as amended, 35 U.S.C. § 33, 35 U.S.C.A. § 33. It would accomplish little to require that claims be separately written if they are not to be separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to "particularly point out and distinctly claim" an identifiable invention or discovery. We have frequently held that it is the claim which measures the grant to the patentee. \* \* \* While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive.'

We are unable to note here any ambiguity in the claims in question. Hence, in this respect, we find



ourselves in the position of the Court of Appeals of the Seventh Circuit in *Borg-Warner Corp. v. Mall Tool Co.*, 217 F. 2d 850, 856. There the court, which had been reversed in the *Graver Tank & Mfg. Co.* case, *supra*, noting that there was no ambiguity in the claims there in question, said that 'to limit those words \* \* \* by reference to the specifications seems to us to go beyond what we are permitted to do under the Supreme Court's decision in the *Graver* case.'

In *Payne Furnace & Supply Co. v. Williams-Wallace Co.*, *supra* [117 F. 2d 828], in suggesting that 'the drawings and specifications elucidate the claims', and that certain limitations were 'implicit in the spirit of the invention claimed', we commented upon the desirability of not striking down 'a meritorious invention.' In view of the decision in the *Graver* case, we do not feel that we can do here what we did in the *Payne Furnace* case, regardless of the meritorious character of the *Winslow* invention.

We hold therefore that the appellant's claims are invalid for failure to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery', or, as the new statute puts it, it has failed to conclude with claims 'particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.' ''

We submit that the rule of law expressed by the Supreme Court in the *Graver Tank* case, and properly applied by this Court in the *Winslow* case should have been applied in this case. If this had been done, then the *Reading* claims would have been declared invalid. In view of the *Graver Tank* and *Winslow* decisions, this Court, as a

matter of law, committed error in referring to the specifications to limit the Reading claims in order to save the patent. Without reference to the specifications, the Reading claims are guilty of overclaiming Reading's invention and are invalid. This Court's decision in the instant case is directly contrary to the Supreme Court's decision in the *Graver Tank* case and this Court's decision in the *Winslow Engineering* case.

It is submitted that this Court should grant a rehearing and should apply the doctrine of the *Graver Tank* and *Winslow* cases to the instant case.

Dated, San Francisco, California,  
March 24, 1959.

Respectfully submitted,

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